

Application No. 10/803,950
Amendment dated December 27, 2006
Reply to Office Action of September 27, 2006

Docket No.: 42339-199895

REMARKS

Reconsideration of this Application is respectfully requested. In response to the Office Action mailed September 27, 2006, Applicants have amended the title, specification, and the claims. Claims 1-26 are pending.

Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider and withdraw all outstanding objections and rejections.

Examiner Telephonic Interview

Applicants thank the Examiner for the clarification provided during the telephone discussion of November 27, 2006. Claims 18-26 were discussed regarding the inclusion of "carrier wave" as a type of machine-accessible medium. The Examiner indicated that "carrier wave" needed to be removed from the specification to overcome the rejections.

Objections to the Specification

On pages 2-3, section 3, the title, specification and Abstract are objected to as being allegedly unclear and/or mis-descriptive.

3a. The title is amended to clarify that "the present invention may use a computer's firmware rather than a hardware disk-controller to provide both the isolation and protection of a region of a hard disk for use by the firmware." See, e.g., paragraph 13.

3b. Applicants respectfully disagree with the Action's characterization of the phrase "software RAID" as being mis-descriptive in the context of the application as a whole. However, in the interest of advancing prosecution, the Abstract is amended to state a "software controlled RAID without the use of a hardware controller".

3c(1). Applicants respectfully disagree with the Action's characterization of the phrase "software RAID" encompassing the scope of an entire RAID system configured in software alone. However, in the interest of advancing prosecution, paragraph 16 is amended to clarify that a "software RAID" as referred to in the description is a RAID controlled by software only.

3c(2). Paragraphs 13 and 14 are amended to correct the reference number used for the firmware.

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3d. "Machine-accessible medium," as defined by the specification in paragraph 4, is amended to remove "a carrier wave used to carry machine-accessible electronic data, such as those used in transmitting and receiving e-mail or in accessing a network," rendering the objection moot.

Paragraphs 29-31 do not specifically recite a "machine-accessible medium."

Paragraph 30 discusses the transfer of software and data between an exemplary computer system and external devices via a communications interface. The software and data may be in the form of signals. The Action does not state how the interface and transfer of data described in paragraph 30 is not "true and accurate."

Paragraph 31 discusses the terms "computer program medium" and "computer usable medium," which "may act as means for providing software to computer system 400." The Action does not state how such terminology is not "true and accurate."

Applicants' respectfully submit that the specification as amended is not unclear or mis-descriptive, and request that the objections be withdrawn.

Allowable Subject Matter

In the Action on page 7, section 13, claims 2-8 and 10-17 are objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form. Applicants thank the Examiner for the indication of allowable subject matter. However, as Applicants believe that the base claims as amended are allowable, Applicants defer placing the claims in independent form at this time.

Rejections under 35 U.S.C. 101

In the Action on pages 4-5, section 7, claims 18-26 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In the Action on page 6, section 8, claims 18-26 are rejected under 35 U.S.C. § 101 as being allegedly inoperative. The example of a "carrier wave" is removed from the definition of "machine-accessible medium," rendering the rejections moot.

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In the Action on page 6, section 10, 18-26 are rejected under 35 U.S.C. § 101 as reciting mixed use of method limitations and apparatus limitations. Applicants respectfully traverse the rejection.

The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, published 22 November 2005 in the Official Gazette ("the Guidelines") clearly state: "Note that an apparatus claim with process steps is not classified as a 'hybrid' claim; instead, it is simply an apparatus claim including functional limitations." The Guidelines, section IV. B. The Action relies on *Ex Parte Lyell*, 17 USPQ2d 1548 for the proposition that claim 18 recites two statutory classes. In fact, *Ex Part Lyell* stands for the proposition that an apparatus claim that recites a method of using the apparatus is indefinite. Claim 18 is an apparatus claim having functional limitations and does not recite a method of using the apparatus. Further, "when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." M.P.E.P. 2601.01. Applicants respectfully request that the rejection be withdrawn.

Rejections under 35 U.S.C. 112

In the Action on pages 3-4, section 5, claims 1, 9 and 18 are rejected under 35 U.S.C. 112, first paragraph as being allegedly not enabled. Claims 1, 9 and 18 are amended to recite, for example, "access to said protected area independently of any hardware controller of said memory device."

Applicants respectfully submit that the claims as amended are enabled and request that the rejection be withdrawn.

In the Action on page 6, section 9, claims 18-26 are rejected under 35 U.S.C. 112, first paragraph as being allegedly not enabled. The example of a "carrier wave" is removed from the definition of "machine-accessible medium," rendering the rejection moot.

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In the Action on page 7, section 12, claims 18-26 are rejected under 35 U.S.C. 112, second paragraph as being allegedly indefinite. Applicants respectfully traverse the rejection. The Action asserts that it is unclear as to whether claims 18-26 claim a manufacture or a method. As stated above, claims 18-26 claim an apparatus with functional limitations and are not indefinite. Applicants respectfully request that the rejection be withdrawn.

As there are no other rejections, Applicants respectfully request that the claims be allowed.

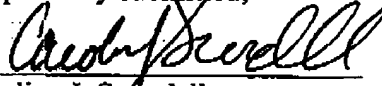
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Dated:

December 27, 2007

Respectfully submitted,

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